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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Takahiko Kawashima

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STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

ZURITA, JAMES H

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/760,878	Applicant(s) KAWASHIMA ET AL.	
	Examiner James H. Zurita	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/03/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20080227</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Applicant's Reply/Amendment

On 3 December 2007, applicant responded to the non-final rejection of 3 July 2007. No claims were amended.

Applicant submitted several Information Statements on 9 July 2007, 10 July 2007 and 3 December 2007.

Information Disclosure Statement

Applicant did not specifically respond to the Examiner's comments concerning the IDS filed 06 April 2007. However, submissions of 9 July 2007, 10 July 2007 and 3 December 2007 appear to correlate to references in the IDS of 6 April 2007.

Response to Arguments

Applicant's arguments filed 03 December 2007 have been fully considered but are not persuasive. Applicant argues,

Obviousness is a question of law based on underlying factual inquiries...
(2) Ascertaining the differences between the claimed invention and the prior art; and
(3) Resolving the level of ordinary skill in the pertinent art. (See, Examination Guidelines, page 57527, col. 1).
Applicants respectfully submit that the Examiner erred in the Graham-factual inquiries in holding the modification of Chang as obvious and teaching recited features of claim 1, for example in whole.

In response, the Examiner notes that item (1) determining the scope and content of the prior art, is absent from Applicant's analysis. However, item (1) is found in the rejections under 35 USC 103.

- (1) Chang discloses [...]...
- (2) Chang does not specifically disclose [...] and

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(3) It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend...to disclose...One of ordinary skill in the art at the time the invention was made would have been motivated to extend ...to disclose ...for the obvious reason that ...

Applicant argues,

Applicants submit that the arguendo converting methodology in Chang is directed toward interfaces within a computer system and not between servers. Accordingly, Applicants submit that the Examiner errs in that one of ordinary skill in the art would have modified Chang to convert between different and specified servers. In fact, Chang does not disclose the term "server." Response, page 11.

Applicants submit that the Examiner **errs** in that one of ordinary skill in the art **could not** have modified the claimed elements by known methods and that the recited elements do not merely perform the function that each element performs separately.

Server In response, during patent examination, pending claims are "given their broadest reasonable interpretation consistent with the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Applicant now appears to argue that his use of servers is different from Chang's. See rejection under 35 USC 112, required by applicant's remarks. See, also servers as PRIOR ART, Fig. 1 in applicant's drawings.

Chang does not use the term server; Chang discloses servers. Server(s) are inherent on the Internet and World Wide Web. Chang discloses the Internet and the world wide web, HTML, XML, W3C. See, for example, at least section entitled Background of the Invention. The Examiner submits that an ordinary artisan possesses knowledge and skills rendering him capable of combining prior art references.

Artisans of ordinary skill

Applicants are reminded that patents are written by and for skilled artisans. See *Vivid Technologies Inc. v. American Science and Engineering, Inc.* 200F.3d 795, 804,

53 USPQ2nd 1289, 1295 (Fed. Cir. 1999). To date, the examiner has presumed that ***Applicant*** is a skilled artisan who possess at least ordinary skill in the art.

Consequently, it is the Examiner's position that because the patent references of record are directed to those with ordinary skill in the art, these references are clear, explicit and specific as to what they teach.

Nevertheless, some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, applicants are hereby given actual notice that if after reasonably reading any reference of record, whether the reference is currently of record or subsequently made of record, if applicants can not reasonably understand or if applicant have difficulty comprehending one or more sentences, statements, diagrams or principles set forth in one or more of the references of record, applicants should, in their next appropriately filed response, bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 CFR 1.111(b), applicants response must also state why they either do not understand or have difficulty with the references.

Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in

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entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Again, the Examiner explains the cited reference and the interpretation of applicants' claims in view of the disclosures. Applicant does not mention "...structure data..." and is not defined. The term is given its broadest reasonable interpretation to refer to XML tags, metadata, as in Fig. 6. This interpretation is supported by Applicant's arguments concerning interpretation by one of ordinary skill in the art. Transaction slip data is interpreted as referring to an XML document. The Examiner makes this interpretation based on applicant's Fig. 2 (prior art). Extracting structure data is interpreted as extracting XML tags from an XML document.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

The term “server” in claims 1-2, 4-14, is used by the claim to mean some entity other than Chang’s inherent servers. The term is indefinite because the specification does not clearly redefine the term. Applicant’s new interpretation contradicts admissions that servers are prior art. See Fig. 1, PRIOR ART.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2, 4-14, as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang (US 6,584,459).

Chang discloses an EDI/XML environment that manages documents containing data (applicant’s transaction slip data documents) in electronic commerce, with database devices.

As per claims 1, 6, 7 and 11, Chang discloses:

- ***extracting*** structure data as a search item of the transaction slip data document therefrom. See, for example, at least Col. 20, lines 1-50. For transaction detail information extracted, see, for example, at least Col. 5, line 50-Col.6, line 15. Detail transaction data includes price, publication date, for example.
- ***storing*** the structure data extracted as management data in correlation with the transaction data; see, for example, management data, such as publisher, as in Col.5, lines 17-45.

- **searching** the management data so as to extract correlated transaction slip data.
See at least Col. 7, lines 45-67.
- **transmitting** the transaction slip data extracted [in the search step] over a network.
See at least sending results to interfaces, at least Col. 6, line 17-line 45.
- **receiving** the transmitted slip data. See, for example, at least Figs. 1, 2 and related text, and references to various units that receive transmitted detail data.
- **converting** a first format of the received transaction slip data into a second format based on a transmission destination (see, for example, converting and storing formats according to destination such as internal and external targets, as in Col. 7, lines 53-67).

Chang **does not** specifically disclose that the first format of the received transaction slip data is usable by an order issuer (buyer) and the second format based on a transmission destination is usable by an order acceptor (seller) in an electronic business transaction between the order issuer and order acceptor without requiring a tailoring of servers of the order issuer and the order acceptor. Chang discloses a relational facility that allows users to define new and distinct data types and subtypes, according to user expectations. See, for example, at least Col.7, lines 38-54.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend Chang to disclose that the first format of the received transaction slip data is usable by an order issuer (buyer) and the second format based on a transmission destination is usable by an order acceptor (seller) in an electronic

business transaction between the order issuer and order acceptor without requiring a tailoring of servers of the order issuer and the order acceptor.

One of ordinary skill in the art at the time the invention was made would have been motivated to extend Chang to disclose that the first format of the received transaction slip data is usable by an order issuer (buyer) and the second format based on a transmission destination is usable by an order acceptor (seller) in an electronic business transaction between the order issuer and order acceptor without requiring a tailoring of servers of the order issuer and the order acceptor for the obvious reason that there is a need to manage an abundance of XML documents, and a need for a product that understands document structures and allows a user to store, search using structure queries and retrieve XML documents and their data within a database system. See, for example, Fig. 2, DB2 XML extender, which converts data to and from formats used by other systems and parties.

As per claim 2, Chang discloses that correlation between data is managed with a key that is common. See, for example, at least references to DocId, Index, Key, RID, at least Fig. 4, 6, 12-13 and related text. See also at least Col. 19, line 1- Col. 20, line 50. See also references to primary keys, foreign keys, DTDId, and other keys that correlate data among the various data objects, at least Col. 13, line 1-Col. 15, line 48.

As per claim 4 Chang discloses that users are allowed to define new searches for retrieval of XML documents. See, for example, Col. 6, lines 19-45.

As per claim 5, Chang discloses

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- that the document containing transaction data is an XML document. See, for example, at least Col. 2, line 18-Col. 3, line 24, Col. 3, line 47-Col. 4, line 18, Figs. 3, 8, 9 and related text.
- that users are allowed to define new searches for retrieval of XML documents. See, for example, at least Col. 6, lines 38-45, Col. 7, line 54-Col. 8, line 3. As per claims 5, 10 and 14, a user may alter targets of a search by changing a search query according to particular tags found in XML documents, such as an author tag in XML document of Col. 5 that is used as a search parameter in the query found in Col. 20.

Claim 6 is rejected on the same grounds as claim 1.

Claim 7 is rejected on the same grounds as claim 1.

As per Claim 8, Chang discloses changing the structure data of a document to be considered including the management data. Chang discloses that users may define new searches by changing search parameters such as management data. See, for example, at least Col. 6, lines 38-45, Col. 7, line 54-Col. 8, line 3.

Claim 9 is rejected on the same grounds as claim 5.

Claim 10 is rejected on the same grounds as claim 5.

Claim 11 is rejected on the same grounds as claim 1.

Claim 12 is rejected on the same grounds as claim 8.

Claim 13 is rejected on the same grounds as claim 5.

Claim 14 is rejected on the same grounds as claim 5.

Conclusion

Applicant's comments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

27 February 2008
/James H Zurita/
Primary Examiner,
Art Unit 3625